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Paper No.

STEPTOE & JOHNSON, LLP  
2121 AVENUE OF THE STARS  
SUITE 2800  
LOS ANGELES CA 90067

**MAILED**

**MAR 26 2009**

**OFFICE OF PETITIONS**

In re Application of :  
Anthony Fontaine, Hyon Im :  
and Wesley Park : DECISION REFUSING STATUS  
Application No. 10/033,716 : UNDER 37 CFR 1.47(a)  
Filed: December 27, 2001 :  
Attorney Docket No. 83336.0559:

This is a decision on the "PETITION TO ACCEPT THE OATH AND DECLARATION IN A NON-PROVISIONAL APPLICATION WITHOUT INVENTORS' SIGNATURES," filed June 11, 2002. This petition was recently forwarded to the undersigned for consideration.

Preliminarily, in reviewing this petition, it is noted that a review of the record supports that this petition is not moot. Although prosecution continued despite the absence of a decision on petition, there is no indication in the records that this matter was resolved.

The petition is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 C.F.R. § 1.136(a).

The above-identified application was filed on December 27, 2001, without an executed oath or declaration. Accordingly, on February 6, 2002, applicants were mailed a "Notice to File

Missing Parts of Nonprovisional Application," requiring submission of an executed oath or declaration and payment of the surcharge for late filing under § 1.16(e). This Notice set a two-month period for reply, with extensions of time obtainable under § 1.136(a).

In response, rule 47 applicants filed the instant petition, along with payment of the petition fee and of the late surcharge; and a declaration executed by joint inventor Fontaine on behalf of himself and on behalf of non-signing inventors Im and Park. This petition was made timely by an accompanying petition for response within the second month. On petition, applicants assert that status under § 1.47(a) is proper because applicants cannot find or locate any forwarding addresses for inventors Im and Park. In support thereof, applicants submit the declaration of facts of attorney Monica J. Finta.

A grantable petition under 37 C.F.R. § 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or found, after diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. The instant petition does not satisfy requirement (1).

The petition includes a declaration, payment of the petition fee of \$130 (the rate in effect on the date of filing of this petition) and states the last known addresses for non-signing inventors Im and Park.

However, with respect to requirement (1) above, rule 47 applicants have not submitted adequate proof, as alleged, that the non-signing inventors cannot be reached or found after diligent effort. The declaration of attorney Finta describes sending the application papers to the non-signing inventors at their place of employment. The evidence supports a conclusion that inventor Im received those papers as he acknowledged receipt in a telephone conversation. This evidence is sufficient to support a conclusion that by his conduct in never responding to the request to sign the declaration, he refuses to join in the application. This evidence is not sufficient to support a conclusion that the inventors cannot be reached or found after diligent effort.

With respect to both inventors Im and Park, the evidence submitted shows that the application papers were received by the employer; however, ultimately the employer responded that both inventors were no longer employed there. Further, they did not have a forwarding address to which to send the application papers. No evidence is submitted of efforts undertaken to present the application papers to the inventors at the addresses where they customarily receive mail (their residence address as shown on the declaration). Even if it is contended that the inventors once customarily received their mail at the address of the employer, it is clear that they no longer did as of their termination of employment. Applicants do not indicate that they utilized resources such as the Internet to locate the inventors. If further attempts to reach the inventors at the addresses where they customarily receive mail or to obtain forwarding addresses or to locate the non-signing inventors by other means such as through a working E-mail address, directory assistance, or the Internet continue to fail, then applicants will have provided the necessary proof required under 37 CFR § 1.47 that the inventor cannot be reached.

Any renewed petition should include copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the non-signing inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the non-signing inventor should be included in the statement of facts by a person with firsthand knowledge of those facts.

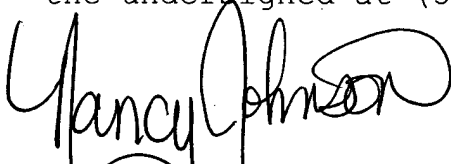
Further correspondence with respect to this matter should be addressed as follows:

By mail:           Mail Stop Petition  
                  Commissioner for Patents  
                  P.O. Box 1450  
                  Alexandria, VA 22313-1450

By FAX:           (571) 273-8300  
                  Attn: Office of Petitions  
                  ATTN: NANCY JOHNSON

By hand: Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Telephone inquiries related to this decision may be directed to  
the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson". The signature is stylized with a large, looping initial "N" and a cursive "Johnson".

Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions